

REMARKS/ARGUMENTS

Status of the Application

In the Office Action, claims 31-35 were rejected. In the present Response, claims 32-34 are amended and claims 36-38 have been added so that claims 31-38 are pending. No new matter has been added.

As the Examiner indicated that Claims 33 and 34 would be allowed if rewritten in independent form 1) to include all of the limitations of the base claim and any intervening claims and 2) to overcome the 35 USC § 112, § 112, 2nd rejections, Applicants respectfully assert that newly added Claims 36 and 37 are in condition for allowance.

Rejections Under 35 U.S.C. § 112, 2nd Paragraph

Claims 32-34 were rejected under 35 U.S.C. § 112, 2nd paragraph as allegedly “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.”

Specifically, the Examiner asserts that the “term ‘considerable’ in claims 32 and 33 is a relative term which renders the claim indefinite.” The Examiner claims that the term “considerable” is not defined by either the claims, or specification, and would not reasonably apprise a person of ordinary skill in the art as to the scope of the invention. The Examiner concludes that as a result, “[i]t is unclear how much water is ‘a considerable amount.’”

The Examiner further argues that claims 32-34 are indefinite because it is allegedly unclear as to what is meant by the limitation “converting the mixture into an aqueous phase.” The Examiner claims that Applicants’ aqueous dispersion is comprised of an aqueous, continuous, and dispersed phase, and therefore “it is unclear [either] what aqueous phase the mixture is being converted into[,] or how such a conversion is achieved.”

Applicants, however, have amended claims 32-34 to more clearly define their claimed invention, and therefore respectfully assert that the Examiner’s rejections as to these claims have been rendered moot. Claims 32-34 have been amended for reasons related only to clarity, and not for any

reasons related to patentability. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

Rejections Under 35 U.S.C. § 103(a)

Claims 31, 32 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,306,998 A to Wenzel in view of WO Patent No. 97/49739 A1 to Das. The Examiner asserts that Applicants' claimed invention is obvious because it would have been obvious to one of ordinary skill in the art to utilize the composition of Wenzel as the pigmented base coat in the color-plus-clear coating method of Das. The Examiner claims that the person of ordinary skill in the art would have been motivated to combine the references "by the suggestion of Das that doing so would eliminate coating defects."

As to claims 31 and 35, the Examiner asserts that in the abstract, at column 2, line 40 to column 5, line 37 and at column 6, line 1 to column 7, line 18 Wenzel "teaches a method of applying to a substrate a lacquer layer from a water-borne lacquer comprising an aqueous binder dispersion of a polyurethane resin into which has been incorporated about 0.3 to 50 wt.-% water insoluble cellulose ester". The Examiner further asserts that Wenzel teaches at column 6, line 64 to column 7, line 2 that his "dispersions...are particularly suitable for use as coating compounds for any flexible or rigid substrate such as leather, textiles, rubber, synthetic materials such as PVC, glass, metals, paper, or wood, where they may fulfill the function of a finish, lacquer or adhesive."

The Examiner, however, correctly recognizes that Wenzel fails to "teach applying the aqueous dispersion as a base lacquer and applying a clear lacquer layer thereto", and therefore turns to Das.

The Examiner claims that Das discloses at column 1, lines 8-12 that "aqueous cellulose ester dispersions may be used as the colored or pigmented base coat in color-plus-clear coating systems", and that "the base-coated substrate is over-coated with a transparent or clear lacquer layer." The Examiner further asserts that column 1, lines 18-25 of Das indicates that

“[c]ellulose ester particle dispersions eliminate coating defects through proper rheological control.”

As to claim 32, the Examiner asserts that Wenzel “teaches [at column 4, lines 19-40] that the water-insoluble cellulose ester is mixed with the polyurethane resin in the absence of water, prior to the addition of water to form the aqueous dispersion”.

As § 2142 of the MPEP indicates, a *prima facie* case of obviousness is only established when there 1) is some suggestion or motivation to modify or combine the cited prior art references, 2) is a reasonable expectation of successfully producing the claimed invention via such a combination, and 3) all of the claim limitations are either taught, or suggested by the cited prior art. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not base on applicant’s disclosure.” MPEP § 2142. Applicants, however, respectfully assert that as there is neither any motivation to combine Wenzel with Das, nor a reasonable expectation of successfully achieving the claimed invention through such a combination, the Examiner has failed to establish a *prima facie* case of obviousness necessitating the withdrawal of this rejection.

Indeed, MPEP § 2143.01 expressly indicates that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.”

Das, however, is directed at acrylic copolymer dispersions containing at least about 5%, and preferably from about 10 to 30 wt.% cellulose ester that can be used in aqueous base coats; whereas Wenzel is directed at polyurethane dispersions containing about 0.3 to 50%, preferably 1 to 20% by weight, auxiliary agents and additives, wherein cellulose derivatives are identified as being but one of the contemplated auxiliary agents and additives. In fact, as the Examiner noted, Wenzel fails to indicate anywhere therein that his polyurethane dispersions can be used to prepare aqueous

base coats that are employed in base coat–clear coat multilayer coating processes used for coating automobiles and parts thereof in accordance with the process of Das.

Although Wenzel cursorily mentions that his polyurethane dispersions can be used “as coating compounds for any flexible or rigid substrate such as leather, textiles, rubber, synthetic materials such as PVC, glass, metals, paper, or wood, where they may fulfill the function of a finish, lacquer or adhesive”, all of his examples are focused exclusively on producing acceptable finishes for leather goods. Nowhere does Wenzel ever mention that his polyurethane dispersions can be successfully used in a water-borne base lacquer that is applied as the base lacquer layer in a multilayer base coat-clear coat coating process—and certainly never mentions that such dispersions can be successfully used in aqueous base coats used to coat automobiles and parts thereof.

As a result, Applicants respectfully request the Examiner to further indicate why a person of ordinary skill in the art would have been motivated to use the **polyurethane** dispersions of Wenzel in the **acrylic** polymer dispersion process of Das when Das never mentions that his process can be used with **polyurethane** based dispersions and Wenzel never indicates that his **polyurethane** dispersions can be used in **acrylic** polymer dispersion containing aqueous base coats that are used as the base coat in a base coat-clear coat multilayer coating process used to coat automotive bodies and parts thereof in accordance with the process of Das.

While the Examiner claims that the requisite motivation comes from Das’ alleged suggestion that incorporating cellulose ester particles eliminates coating defects, Applicants respectfully assert that there is not a single teaching in either reference to indicate that the cellulose ester containing **polyurethane** dispersions of Wenzel could be successfully used in an aqueous base coat that is employed in a basecoat-clear coat multilayer coating process used to coat automotive bodies and parts thereof in accordance with the process of Das.

As a result, Applicants respectfully assert that the only motivation to combine Wenzel with Das arises from the wisdom of hindsight. As Section 2143.01 of the MPEP indicates, however, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” As neither Wenzel, nor Das suggest the desirability of combining the two references so as to arrive at Applicants’ claimed invention, Wenzel and Das in combination fail to render Applicants’ claimed invention obvious. Accordingly, Applicants’ respectfully request that the Examiner withdraw this rejection.

Furthermore, as neither reference indicates that combining the **polyurethane** dispersions of Wenzel with the **acrylic** polymer dispersion containing water-borne base coats of Das could successfully produce coatings acceptable for coating automotive bodies and parts thereof in accordance with the process of Das, there was no reasonable expectation that combining Wenzel with Das would successfully produce Applicants’ claimed invention. In fact, as already indicated hereinabove, the Examples of Wenzel focused exclusively on producing acceptable aqueous leather finishes, and never mentioned that such dispersions could be used as an aqueous base coat in a multilayer coating for an automotive body or part thereof. Applicants respectfully assert that the requisite expectation of success is not coming from Wenzel and Das, but rather is coming from hindsight coupled with Applicants’ disclosure. As a result, Applicants respectfully request that the Examiner further explain why a person of ordinary skill in the art would have reasonably expected Wenzel to be successfully combinable with Das so as to produce a water-borne base coat that could be successfully used as the base coat in the base coat-clear coat multilayer coating process that Das indicates produces acceptable finishes on automotive bodies and parts thereof. As neither Wenzel, nor Das contain a single disclosure that would lead a person of ordinary skill in the art to reasonably expect that Wenzel could be combined with Das so as to arrive at Applicants’ claimed invention, the Examiner has failed to establish a *prima*


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facie case of obviousness. Accordingly, Applicants' respectfully request that this rejection be withdrawn.

Summary

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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Dated: